

PATENT APPLICATION NUMBER: 10/718,390
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application Number 10/718,390

Filed November 20, 2003

Inventor Ronald F. Palermo

Art Unit 1791

Examiner J. Wollschlager

Confirmation 9732

Docket Number 1067 001 301 0202

- ☒ Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.
- ☒ This request is being filed with a notice of appeal.
- ☒ The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 34,545.
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____.

Signature /Duane C. Basch, Esq. Reg. No. 34,545/

Typed or Printed Name Duane C. Basch

Telephone Number 585-899-3970

Date May 15, 2008

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required,

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully submit that the rejections are improper and request that they be withdrawn.

Rejections under 35 USC §112, first paragraph

Independent claims 1 and 20 were rejected for use of the term “non-cementitious decorative aggregate.” The Examiner alleges that the claimed subject matter was not described so as to demonstrate to one of skill in the art that the inventors had possession of the claimed invention. In setting forth such a rejection, the Examiner bears the burden of establishing a *prima facie* basis for the rejection, by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. No such statement or reasons have been supplied by the Examiner. Hence, Applicants maintain that the rejection is improper.

Furthermore, the term cementitious was used in characterizing not only concrete (p. 2; “Concrete is a cementitious [sic] building material created by combining a mineral filler such as sand and gravel or similar aggregate with a binding agent, such as Portland cement, and water.”), but also in describing the manner of producing terrazzo floors (p. 3). In the Detailed Description, Applicants set forth various examples of decorative aggregates (e.g., p. 7, lines 9-13) – none of which include a binding agent such as Portland cement (i.e., non-cementitious). As MPEP §2163.02 specifically states, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” Thus, the exemplary aggregates listed clearly set forth a number of non-cementitious aggregates – establishing for one of reasonable skill in the art that Applicants indeed had possession of the claimed invention. Applicants respectfully submit that a person skilled in the art would recognize in the disclosure a description of the invention defined by the claims (e.g., non-cementitious decorative aggregate). See e.g., *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

Independent claim 20 was also rejected for the use of the transitional phrase “consisting of.” However, the Examiner again failed to establish a *prima facie* basis for the rejection, and fails to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the Applicants were in possession of the specific method in view of the disclosure in the application.

Furthermore, the limitations set forth in claim 20 are described at pages 6 – 7 of the as-

filed application. Accordingly, Applicants demonstrated that the recited steps were those believed required to complete the invention. As to the Examiner's response noting additional floating operations, Applicants urge that the Specification clearly indicates that floating and trowelling are used to integrate the aggregate (e.g. p. 10, line 17) as recited in claim 20.

Regarding claim 11, the Examiner appears to ignore that the general range of grits set forth at pp. 13 – 14 as "having a grit from about 20 to 3,000." Moreover, the descriptions of various exemplary grits and ranges were generally preceded by "about" or "approximately," and are urged as sufficient so that a person skilled in the art would recognize in the disclosure a description of the invention defined by the amended claim.

In view of the Examiner's failure to set forth adequate bases for the rejections, and in light of the support for the claims as briefly described in the above remarks, Applicants respectfully traverse the rejections under 35 USC §112, first paragraph.

Rejections under 35 USC §103(a)

Claims 1-5, 7-10 and 20 were rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146). The disclosures of the cited art and the distinctions between Shaw and Danielsson or Harvey may be summarized as follows:

Shaw discloses a surface-seeded, exposed particulate concrete. Relative to surface seeding/exposure, Shaw teaches at col. 1, lines 22-48, that the exposure of aggregate leads to surface roughness when large aggregate is used and precludes use of the technique in flooring. This statement suggests that Shaw's teaching of exposed particulate arises through the removal of concrete material, and not the particulate. In other words, the teaching indicates that the aggregate exposure taught by Shaw does not intend to remove the aggregate material itself (no more than 5%; col. 4, lines 36-50), but exposes the surface of such aggregate. Such a teaching is contrary to the presently claimed invention and thus teaches away from the limitations set forth in the claims – removing both concrete and integrated aggregate to expose the aggregate uniformly over the top of the concrete. While Shaw does suggest that sandblasting, acid etching or grinding and polishing may also be used to create texture variations (col. 4, lines 63-65), Applicants urge these treatments to be selective treatments to create texture variations, which would appear to further teach away from the present invention – a generally planar and smooth surface. Shaw not only fails to teach partially curing the concrete followed by grinding the partially cured concrete, including removing some

integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, but it is clear that Shaw intends for the aggregate to be exposed using non-grinding steps (water, sponge, broom; col. 4, lines 44-49) to produce a non-uniform surface. Thus, Shaw teaches away from a grinding of the aggregate in partially cured concrete. While Shaw does disclose various methods “to create texture variations on the surface” (col. 4, lines 60-65), Applicants respectfully maintain that this does not give rise to the teaching being alleged by the Examiner.

The rejection also improperly relies upon Danielsson in combination with Shaw. First, Danielsson expressly teaches away from the use of trowelling or finishing of the concrete (col. 3, lines 30-35; col. 7, lines 55-65) but uses the process of grinding following floating to produce a “flat porous surface having a sanded characteristic” (col. 6, lines 50-52; col. 8, lines 8-10; col. 9, lines 30-32). Danielsson does not teach grinding to achieve uniformly exposed aggregate as required by the rejected claims. Rather, Danielsson consistently teaches grinding to produce a surface with a sanded quality. Applicants remind the Examiner that Danielsson is not directed to providing an exposed surface flooring, but a subfloor upon which “tile, carpeting or the like” may be applied (see object of the invention at col. 5, lines 53-55). Applicants further submit that the teachings of the densification operation of Danielsson clearly establish that densification is employed to produce an upper layer of sand, concrete and water (col. 7, lines 38-40), such that a thin surface layer (col. 8, lines 7-9) can be removed to “produce a flat, porous surface having a sanded quality...” (col. 8, lines 8-10). Not only does Danielsson not teach the removal of aggregate in the grinding operation, it specifically teaches densification to cause the upper layer to be substantially free of the aggregate that is present in the concrete. Applicants, once again, urge this is contrary to the teachings of Shaw, and to the limitations set forth in the rejected independent claim 1. As a result of the contrary teachings of Shaw and Danielsson, Applicants respectfully maintain that the two patents are not properly combined and that *prima facie* obviousness has not been established. Accordingly, the rejection of independent claims 1 and 20 over Shaw in view of Danielsson is respectfully traversed.

Considering, *in arguendo*, a combination of Shaw and Danielsson, both fail to teach or suggest the recited limitation of grinding the upper surface of a partially cured concrete with the integrated aggregate therein until the aggregate is exposed uniformly over the top of the concrete. Absent a teaching of all claim limitations in the recited order (claim 1), or the teaching of only the recited limitations (claim 20), the rejection for obviousness is incomplete, and Applicants hereby traverse the rejection based upon the arguable

combination of Shaw in view of Danielsson.

Turning next to the alternative rejection over Shaw in view of Harvey, Applicants note that Harvey similarly teaches away from the claimed invention, and Shaw as well, in that Harvey is directed to producing a finished floor surface that is poured in place over an existing subfloor (wood or concrete; col. 2, lines 39-43). In other words, Harvey teaches away from forming an integrated ornamental surface on a monolithic concrete floor as Harvey expressly teaches a decorative surface applied over an existing wood or concrete subfloor. Moreover, the additional steps required for the decorative surface taught by Harvey would result in secondary processes and additional costs as compared to Shaw, or the presently claimed invention – further indicating that it would not have been obvious to make the proposed combination.

Applicants further note that Harvey teaches air curing then “after drying,” grinding the top surface, and after sealing the dried surface is ground using sanding wheels (col. 3, lines 58-67). Here again, Harvey does not appear to teach fully curing the concrete and polishing the upper surface of the monolithic concrete floor as recited in the independent claims. In view of the contrary teachings of Shaw and Harvey, and absent a showing of how the teachings of the patents can be combined to describe all of the limitations of the rejected independent claims, *prima facie* obviousness has not been established. Hence Applicants traverse the rejection based upon a combination of Shaw in view of Harvey.

With respect to dependent claims 2-10, Applicants respectfully urge the various arguments set forth above relative to the independent claims and for the sake of brevity further distinctions are not set forth at this time. Applicants reserve the right to present arguments in support of such claims in the appeal brief. The rejection of dependent claims 2-10 is similarly traversed. As to the rejection of claim 6 in further view of Darrow, Applicants note that not only are the specific limitations set forth in claim 6 not taught by Darrow, but as described by the Examiner, Darrow teaches firmness relative to finishing the concrete, not firmness relative to finishing so as disperse aggregate and integrate it in the surface.

Relative to claim 11, neither Shaw, Danielsson or Harvey teach the grinding of an upper surface of a partially cured monolithic floor with integrated aggregate using diamond heads, silicon carbide and a diamond pad. The addition of the Surface Preparation teachings show the polishing of cured concrete, yet fails to teach or suggest the use of diamond cutting heads on partially cured monolithic concrete floors as set forth in claim 11. Applicants maintain that the Examiner has failed to provide a teaching of every

limitation set forth in claim 11 and thus *prima facie* obviousness has not been established. Accordingly, the addition of Surface Preparation does not give rise to a teaching of the further limitations set forth in claim 11.

The rejection also relies upon conclusory statements such as “[t]herefore it would have been *prima facie* obvious ... to have employed conventional grinding means to progressively grind the surface of the concrete.... The combination suggests the specific selection of the means would have been optimized by the artisan” (Final Office Action pp. 6 - 7). Applicants respectfully disagree and continue to urge that the Examiner failed to demonstrate a teaching of grinding partially cured concrete using diamond pads - as set forth in the first limitation of claim 11, for example. Accordingly, the rejection is respectfully traversed.

As for claims 12 and 13, the rejections are respectfully traversed in view of the arguments presented above relative to claims 1 and 11. Applicants, for the sake of brevity, do not identify further distinctions or arguments in traversal, but reserve the right to do so in the appeal brief.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Duane C. Basch', with a long horizontal flourish extending to the right.

/Duane C. Basch, Esq. Reg. No. 34,545/

Duane C. Basch